

Docket No. 9491-018-27X DIV



#22
LJ

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: KEVIN P. BAKER, ET AL.

GAU: 1646

SERIAL NO: 09/236,939

EXAMINER: ULM, J.

FILING DATE: JANUARY 25, 1999

FOR: PROTEIN TYROSINE KINASES

RECEIVED

APR 03 2002

TECH CENTER 1600/2900

**PETITION UNDER 37 CFR § 1.181
FOR REMOVAL OF FINALITY**

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

Applicants hereby petition to remove the finality of the Office Action mailed March 7, 2002 in the above-referenced application. This Petition is decided by the Technology Center Director under MPEP § 1002.02(c)(3)(a). The circumstances necessitating this Petition are as follows.

On December 21, 2001, Applicants filed a Response After Final containing substantial new points of argument. In response, an Advisory Action was issued on January 15, 2002. In reference to the arguments raised in Applicants' above-mentioned Response, the only substantive point within the Advisory Action stated:

"The arguments presented therein should be presented in response to the first instance that a rejection has been made, not after final, wherein such arguments are not limited to those issues newly raised in the final rejection."

In effect, there was no full consideration or response given to answer the extensive new arguments submitted in Applicants' Response filed December 21, 2001. Directly following the Advisory Action, Applicants filed a Continuing Prosecution Application (CPA) on February 4, 2002, enclosing, as a Preliminary Amendment, the same arguments that were not answered in the

Advisory Action. An Office Action was issued March 7, 2002, in response to this CPA. The Office Action has been made final, despite the fact these arguments had been considered new and too extensive for response in the Advisory Action mailed on January 15, 2002.

On March 22, 2002, Applicants' representative telephoned the Primary Examiner and orally requested that such Finality be removed. The Primary Examiner did not acknowledge this request and invited this Petition.

The Manual of Patent Examining Procedure (MPEP) addresses this circumstance under MPEP 706.07(b) FINAL REJECTION WHEN PROPER ON FIRST ACTION:

"...it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search..."

Applicants submit that the substantive arguments first presented in Applicants' Response filed December 21, 2001, and then presented again with the CPA filed February 4, 2002, fall within the above-mentioned definition as material presented after final and denied entry as requiring "further consideration and /or search." The arguments were not addressed in the Advisory Action and were only first addressed in the Office Action mailed March 7, 2002. Applicants note that the Office Action, made final on the first action, directs Applicants toward making extensive changes in the record that can best be addressed in prosecution before the after final stage.

Applicants submit that the changes to the record that may be necessary in responding to the outstanding Office Action could have been brought to Applicants' attention in the Advisory Action, but were not. Instead, substantive arguments were only first raised in the Office Action mailed March 7, 2002.

Applicants respectfully request that the finality of the Office Action mailed March 7, 2002 be withdrawn in order to afford Applicants full opportunity to develop the record as needed should this application need to be taken up on appeal.

Such relief is respectfully requested.

Respectfully submitted,

PIPER, MARBURY, RUDNICK & WOLFE



Steven B. Kelber
Registration No: 30,073
Attorney of Record

Patrick R. Delaney
Registration No: 45,338

March 28, 2002

1200 Nineteenth Street, N.W.
Washington, D.C. 20036-2412
Telephone: (202) 861-3900
Facsimile : (202) 223-2085